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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,415	11/21/2000	Masaru Takeda	107904	8263

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EXAMINER

NGUYEN, HAI V

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/716,415

Applicant(s)

TAKEDA ET AL.

Examiner

Hai V. Nguyen

Art Unit

2142

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 03 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: NONE.
Claim(s) objected to: NONE.
Claim(s) rejected: 1-21.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments received on 09 December 2004 are not persuasive.

In the remarks, Applicant argued in substance that:

Point (A), Applicant argued that there is no motivation or suggestion to combine the prior art on pages 2-3.

As to point (A), in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this instant application, as shown on page 8-9 of the Final Action mailed on 07 September 2004 that "Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Miyahara's teachings of association of distribution cost corresponding to a destination (Miyahara, Abstract, col. 5, lines 38 – col. 6, line 14) with the teachings of Saito-Weschler for the purpose of the selection of suitable distribution cost if the destination have a plurality of distribution means (Miyahara, col. 1, lines 51-56). Saito also suggests that since the communication cost by email is inexpensive, the communication cost can be reduced by using Internet facsimile apparatus 13 locating distance to facsimile apparatus 12 as a relay apparatus (Saito, col. 1, lines 44-47).

Point (B), the prior art does not disclose, "searching for an output apparatus or a plurality of apparatuses" (Applicant's remarks on page 4) in claims 1, 5, 17, 19, 20, and 21.

As to point (B), Weschler discloses that a method and a computer product for searching directories in a computer system ...determining candidate ones of the directories comprising matches to a first of sequence of query strings, iteratively applying remaining ones of the directories and returning a result set of data representative of the candidate ones of said directories having matched each of the specific sequence of query strings (Abstract, col. 5, lines 36-63) and finding the resources in the distributed system is to use directories. Directories are data structure that hold information such as mail address book information, printer locations, public infrastructure ("PKI") information, and the like... (Abstract, col. 5, lines 36-63; col. 4, lines 26-36; col. 9, line 30 – col. 10, line 16). Saito also suggests that

server 3 searches the notified facsimile number of the final destination and returns an e-mail address, the reception capability indicative of processing capability for image information (col. 3, lines 54-60; col. 5, lines 10-15).

Point (C), the prior art do not disclose managing a mail address for each output apparatus in claims 1, 5, 17, 19, 20 and 21.

As to point (C), Weschler discloses that in col. 4, lines 50-57 that "X.500 is one current model for managing on-line directories of users and resources (Directory Services) that includes the overall namespace as well as the protocol for querying and updating it. An X.500 directory is called a Directory Information Base ("DIB") and the program that maintains the DIBs is called a Directory Server Agent ("DSA"). A Directory Client Agent ("DCA") is used to search DSA sites for names and addresses" and in col. 7, lines 65-67, "the profile services API 203 provides management utilities for defining schemas."

Saito discloses that in Fig. 10, item ST1002, that "is there delivery status notification message?" (Saito, col. 8, lines 7-30).

Saito also discloses in claim 3 that, "An Internet facsimile apparatus connected to a computer network, comprising: a scanner that scans an original to obtain image data; a transmitter that transmits image data in e-mail format to a designated destination via the computer network;"

Point (D), the prior art do not disclose notifying the email address of candidate output apparatus in claims 1, 5, 17, 19, 20 and 21.

As to point (D), Saito discloses that in Fig. 10, item ST1002, that "is there delivery status notification message?" (Saito, col. 8, lines 7-30).

Saito also discloses in claim 3 that, "An Internet facsimile apparatus connected to a computer network, comprising: a scanner that scans an original to obtain image data; a transmitter that transmits image data in e-mail format to a designated destination via the computer network;"

Point (E), the prior art do not disclose distinguishing a designate output apparatus based on a destination mail address in claims 1, 5, 17, 19, 20 and 21.

As to point (E), Saito discloses in claim 3 that, "An Internet facsimile apparatus connected to a computer network, comprising: a scanner that scans an original to obtain image data; a transmitter that transmits image data in e-mail format to a designated destination via the computer network;"

Point (F), Applicant challenges "the Official Notice with the well-known features".

As to point (F), Applicant's failure to adequately traverse the Examiner's taking Official Notice in the last Office Action is taken as an admission of the fact(s) noticed. A "seasonable challenge" is an explicitly demand for evident set forth by Applicant in the next response. Accordingly, the claim limitations the Examiner considered as "well known" in the First Office Action through use of Official Notice, i.e., the use of conversion of a PDF file and checking virus in email message in the networking environment, are now established as admitted prior art of record for the course of the prosecution. See *In re Chevenard*, 139 F.2d 71, 60 USPQ 238 (CCPA 1943). The provision for the PDF conversion and virus checking do not constitute a patentable distinction.

